

PATENT
10/023,404

D. REMARKS

Specification

Applicants have amended the specification above to include the application serial numbers of the related cross-references.

35 USC § 102(b)

Claims 1, 2, 4, 6-12, 15-19, 21, 23-29, 31-35, 37-40, and 42-44 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Rosinski et al (US Patent Number 5,381,467) (hereinafter referred to as Rosinski). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed Cir. 1987). Furthermore the reference must be an enabling disclosure of each and every element as set forth in the claim. *In re Hoecksmas*, 158 USPQ 596, 600 (CCPA 1968); *In re LeGrive*, 133 USPQ 365, 372 (CCPA 1962). Because the Examiner does not show that Rosinski teaches each and every element of claims 1-5, 7, 9-14, 16, 18-23, 25, 27-29, 31-32, 34-35 or enables each and every element of these claims, these claims are not anticipated, the rejection should be withdrawn, and the claims should be allowed.

Claim 1, 18, and 35

With respect to claims 1, 18 and 35, the Examiner cites Rosinski as teaching the method, system, and program of claims 1, 18 and 35. Applicants respectfully propose that Rosinski does not anticipate the invention of amended claims 1, 18 and 35 because Rosinski does not teach or enable expressly or inherently the elements of amended independent method, system, and program claims 1, 18, and 35. Claim 1 currently reads:

AUS920010840US1

18

PATENT
10/023,404

1.(Currently Amended) A method for billing for telephone services, said method comprising:

responsive to receiving a call request, identifying and loading a caller billing plan for an authenticated identity of a caller making said call request and a callee billing plan for an authenticated identity of a callee answering said call request; [and]

enabling access to said caller and said callee to a billable service provided by an external service provider accessed from outside a trusted telephone network initially handling said call request; and

responsive to [detecting] providing access to said [a] billable service [with said call request], distributing a cost of said billable service among said caller billing plan and said callee billing plan, such that both said caller and said callee pay for a benefit received from said billable service accessible from outside said trusted telephone network.

In the objection to claim 1, the Examiner cites Rosinski as teaching the element of “responsive to detecting a billable service with said call request” at col. 13 line 15 through col. 14 line 27. Applicants note that col. 13 line 15 through col. 14 line 27 describe the process for enabling the split billing by verifying that the subscriber numbers are numbers signed up for the bill splitting service.

In general, Rosinski describes the interexchange carrier (IXC) 30 in Figure 1 and throughout the description as a carrier in a trusted network where a call is passed from the switches of one carrier to the switches of another carrier. (Col. 4 lines 14-61). In contrast, the amended claim describes enabling the caller and callee to access billable services provided by an

AUS920010840US1

19

PATENT
10/023,404

external service accessed from outside the trusted telephone network handling the call request. The specification teaches and enables external service access in pages 12, line 22 through page 31 line 21. Therefore, Applicants respectfully propose that Rosinski is limited to handling basic calls within a typical PSTN network and therefore since claim 1 is amended to include the element of "enabling access to said caller and said callee to a billable service provided by an external service provider accessed from outside a trusted telephone network initially handling said call request", amended claim 1 is not anticipated by Rosinski. In conclusion, Applicants respectfully request removal of the rejection against amended claim 1 and allowance of amended claim 1.

With respect to independent system claim 18 and independent program claim 35, claims 18 and 35 are amended to reflect the amendments to parallel method claim 1. Therefore, for the same reasons as Applicants request removal of the rejection against amended claim 1, Applicants also request removal of the rejection against amended claims 18 and 35 and allowance of these amended independent claims.

Claims 2, 4, 6-12, 15-18, 19, 21, 23-29, 31-34, 37-40, 42-44

Regarding claims 2, 4, 6-12, 15-18, 19, 21, 23-29, 31-34, 37-40, 42-44, Applicants respectfully propose that because Rosinski does not anticipate amended independent claims 1, 18, and 35 upon which these dependent claims rely, Rosinski also does not anticipate these dependent claims and the dependent claims should be allowed. Specifically, however, Applicants respectfully propose that even if Rosinski anticipates independent claims 1, 18, and 35, Rosinski does not anticipate claims 6-8, 23-25, and 37-39.

Claims 6, 23, and 37

With respect to claims 6 and 23, the Examiner cites Rosinski as teaching the method, system, and program of claims 6 and 23. Applicants respectfully propose that Rosinski does not anticipate the invention of claims 6 and 23, because Rosinski does not teach or enable expressly or inherently the element of claims 6 and 23. Claim 6 currently reads:

AUS920010840US1

20

PATENT
10/023,404

6.(Original) The method for billing for telephone services according to claim 1, wherein authenticating an identity of a caller further comprises:

initiating authentication of said identity of said caller and said callee at an origin device, wherein said origin device is enabled to initiate said call request.

In the objection to claim 6, the Examiner cites Rosinski as teaching "initiating authentication of said identity of said caller and said callee at an origin device (IXC originating switch) (col. 11, lines 45-65), wherein said origin device is enabled to initiate said call request (col. 11, lines 45-65 and col. 13 lines 25-58). [Office Action, p. 3] Thus, in the rejection, the examiner equates the "IXC originating switch" to "an origin device".

Rosinski teaches, however, that the "IXC originating switch" is part of the interexchange carrier (IXC) 30 depicted in Figure 1, where IXC 30 is the interexchange carrier for handling "long distance—or so called interexchange—calls which involve the use of the facilities of a long-distance, or interexchange, carrier, also referred to as an IXC." (Rosinski, col. 4 lines 14-18) Thus, Applicants respectfully note that Rosinski teaches that the IXC originating switch is part of the telephone service "carrier" system; in contrast, devices from which calls originate are depicted in figure 1 as devices 11 and 12 which are physically separate from IXC 30. Further, Applicants respectfully note that the "origin device" described in the present invention is a device that originates a call, as distinguished from an intermediary device which processes the call, and a destination device, which receives the call. (Brown et al. p. 8, lines 12-15) Therefore, because both Rosinski and the present invention distinguish between both the systems and purpose of an origin device and the carrier system (or intermediary device), Applicants respectfully propose that an IXC originating switch does not teach an origin device. Thus, the Examiner does not point out, nor does Rosinski teach an origin device that initiates the authentication of the identity of the caller and the callee. In conclusion, Applicants respectfully request allowance of dependent claim 6 and parallel dependent claim 23.

AUS920010840US1

21

PATENT
10/023,404

With respect to claim 37, the Examiner rejects claim 37 under the same grounds parallel method claim 6 and system claim 23. Applicants respectfully allowance of claim 37 for the same reasons as discussed for the allowance of claims 6 and 23.

Claims 7, 24, and 38

With respect to claim 7 and 24, the Examiner cites Rosinski as teaching the method, system, and program of claims 7 and 24. Applicants respectfully propose that Rosinski does not anticipate the invention of amended claims 7 and 24 because Rosinski does not teach or enable expressly or inherently the elements of amended claims 7 and 24. Claim 7 currently reads:

7.(Currently Amended) The method for billing for telephone services according to claim 1, wherein authenticating an identity of a caller further comprises:

initiating authentication of said identity of said caller and said callee at an intermediary device processing said call request by invoking an authentication service from an external authentication service provider accessed outside said trusted network.

In the objection to claim 7, the Examiner cites Rosinski as teaching "initiating authentication of said identity of said caller and said callee at an intermediary device (terminating IXC switch), wherein said destination device is enabled to receive said call request (col. 11, lines 45-65 and col. 13 lines 25-58). [Office Action, p. 3] Thus, in the rejection, the Examiner equates the "IXC" to an "intermediary device". In particular, Applicants note that the IXC taught by Rosinski includes carrier switches for carriers operating within a standard public switched telephone network (PSTN), or trusted network. (See Rosinski Figure 1, col. 4 lines 14-61). Any caller or callee identification is performed within IXC 30. (Col. 11, lines 45-65 and col. 13 lines 25-58) In contrast, amended claim 7 specifies that the authentication is performed by "invoking an authentication service from an external authentication service provider accessed

AUS920010840US1

22

PATENT
10/023,404

outside said trusted network.” The specification of the present invention teaches and enables a switching carrier accessing a service outside the trusted PSTN in pages 12, line 22 through page 31 line 21 and specifically teaches an outside authentication service provider on page 19 line 15 through page 20 line 28. Therefore, Applicants respectfully propose that Rosinski, which teaches caller identification through entry of a PIN within the IXC does not teach authentication or invoking an authentication service from an external authentication service provider, and therefore does not anticipate claim 7. In conclusion, Applicants respectfully request allowance of dependent claim 7 and parallel dependent claim 24.

With respect to claim 38, the Examiner rejects claim 38 under the same grounds parallel method claim 7 and system claim 24. Applicants respectfully allowance of amended claim 38 for the same reasons as discussed for the allowance of amended claims 7 and 24.

Claims 8, 25, and 39

With respect to claims 8 and 25, the Examiner cites Rosinski as teaching the method, system, and program of claims 8 and 25. Applicants respectfully propose that Rosinski does not anticipate the invention of claims 8 and 25 because Rosinski does not teach or enable expressly or inherently the elements of amended claims 8 and 25. Claim 8 currently reads:

8.(Original) The method for billing for telephone services according to claim 1, wherein authenticating an identity of a caller further comprises:

initiating authentication of said identity of said caller and said callee at a destination device, wherein said destination device is enabled to receive said call request.

In the objection to claim 8, the Examiner cites Rosinski as teaching “initiating authentication of said identity of said caller and said callee at a destination device (IXC), wherein said destination device is enabled to receive said call request (col. 11 lines 45-65 and

AUS920010840US1

23

PATENT
10/023,404

col. 13 lines 25-58). [Office Action, p. 3] Thus, in the rejection, the examiner equates the "IXC" to "a destination device".

Rosinski teaches, however, that the "IXC" is the interexchange carrier (IXC) 30 depicted in Figure 1, where IXC 30 is the interexchange carrier for handling "long distance—or so called interexchange—calls which involve the use of the facilities of a long-distance, or interexchange, carrier, also referred to as an IXC." (Rosinski, col. 4 lines 14-18) Thus, Applicants respectfully note that Rosinski teaches that the IXC originating switch is part of the telephone service "carrier" system; in contrast, devices to which calls are destined are depicted in figure 1 as devices 51 and 52, which are physically separate devices from IXC 30. Further, Applicants respectfully note that the "destination device" described in the present invention are those devices that receive a call, as distinguished from an intermediary device which processes the call. (Brown et al. p. 8, lines 12-15) Therefore, because both Rosinski and the present invention distinguish between both the systems and purpose of a destination device and the carrier system (or intermediary device), Applicants respectfully propose that an IXC does not teach a destination device. Thus, the Examiner does not point out, nor does Rosinski teach a destination device that initiates the authentication of the identity of the caller and the callee. In conclusion, Applicants respectfully request allowance of dependent claim 8 and parallel dependent claim 25.

With respect to claim 39, the Examiner rejects claim 39 under the same grounds parallel method claim 8 and system claim 25. Applicants respectfully allowance of claim 39 for the same reasons as discussed for the allowance of claims 8 and 25.

35 USC § 103(a)

Claims 3, 5, 20, 22 and 36

Claims 3, 5, 20, 22 and 36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rosinski et al. in view of Swope et al. Claim 3 currently reads:

AUS920010840US1

24

PATENT
10/023,404

3.(Original) The method for billing for telephone services according to claim 1, further comprising:

receiving said call request from an origin device at a service provider from an origin line number utilized by said origin device;

loading a profile for a line subscriber of said origin line number, wherein said profile comprises a billing plan for said line subscriber;

extending a dial tone to said origin device;

authenticating said identity of said caller utilizing said origin device;

loading said caller billing plan according to said authenticated identity to replace said billing plan for said line subscriber;

loading a profile for a destination line subscriber of a requested destination line number, wherein said profile comprises a billing plan for said destination line subscriber;

extending a ring signal to a destination device via said destination line number;

responsive to detecting an answer at said destination device, authenticating said identity fo said callee utilizing said destination device; and

loading said callee billing plan according to said authenticated identity to replace said billing plan for said destination line subscriber.

AUS920010840US1

25

PATENT
10/023,404

In particular, the Examiner cites Rosinski as teaching the element of "loading said caller billing plan according to said authenticated identity to replace said billing plan for said line subscriber" at col. 11 line 45 through col. 12 line 45 and as teaching the element of "loading said callee billing plan according to said authenticated identity to replace said billing plan for said destination line subscriber" at col. 13 lines 25-53. [Office Action, pp. 6-7]

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Of the elements of "loading said caller billing plan according to said authenticated identity to replace said billing plan for said line subscriber" and "loading said callee billing plan according to said authenticated identity to replace said billing plan for said destination line subscriber" the Examiner cites Rosinski as teaching replacement of a billing plan for an origin and destination line subscriber with the billing plan identified for the actual person using the line. In the portions of Rosinski cited by the Examiner, however, there is no teaching, explicit or implicit, of replacement of a billing plan for an origin or destination line subscriber with other billing plans, nor the replacement of a billing plan of a subscriber with the billing plan for the person actually using the origin or destination lines. Further, the focus of Rosinski is upon whether both line subscribers have agreed to split billing in association with the line subscriber agreement and does not teach or suggest replacing the billing plans of the origin and destination line subscribers. (Rosinski, col. 11, line 45 through col. 12 line 45)

The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the Examiner does not produce a prima facie case, Applicants are not under an obligation to submit evidence of nonobviousness. As previously described, Applicants respectfully propose that the Examiner has not met the burden of establishing prima facie obviousness for claims 3, 20, and 36 because the limitation of replacing an origin or destination line subscriber billing plan with the billing plan associated with the authenticated caller or callee actually using the line is not taught or suggested by the prior art or addressed by the Examiner. Applicants respectfully request removal of the rejection and allowance of claims 3, 20, and 36.

AUS920010840US1

26

PATENT
10/023,404

Regarding claims 5 and 22, Applicants note the above proposition that independent amended claims 1 and 18 are not taught by Rosinski and therefore as dependent claims of allowable subject matter, claims 5 and 22 should also be allowed.

Claims 13 and 30

Claims 13 and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rosinski in view of Levy. Applicants note the above proposition that independent amended claims 1 and 18 are not taught by Rosinski and therefore as dependent claims of allowable subject matter, claims 13 and 30 should also be allowed.

Claims 14, 31, and 41

Claims 14, 31, and 41 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rosinski in view of Swale et al. Applicants note the above proposition that independent amended claims 1, 18 and 35 are not taught by Rosinski and therefore as dependent claims of allowable subject matter, claims 14, 31, and 41 should also be allowed.

PATENT
10/023,404

Conclusion

Applicants note the citation of pertinent prior art cited by the Examiner.

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims are respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment.

Respectfully submitted,



ON 11/16/2004

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AUS920010840US1

28